



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,525	06/06/2000	Manuel de Jesus Arana Rosainz	294-83	8985

23869 7590 07/01/2003

HOFFMANN & BARON, LLP  
6900 JERICHO TURNPIKE  
SYOSSET, NY 11791

EXAMINER

SHAHNAN SHAH, KHATOL S

ART UNIT	PAPER NUMBER
----------	--------------

1645

DATE MAILED: 07/01/2003

Lo

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/588,525

Applicant(s)

ARANA ROSAINZ ET AL.

Examiner

Khatol S Shahnian-Shah

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 37-84 is/are pending in the application.
- 4a) Of the above claim(s) 71-84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 37-84 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***DETAILED ACTION***

1. Applicants' supplemental response to election of species with out traverse of July 1, 2002 Paper No. 19 is acknowledged. Applicants elected group I (claims 37-70) and SEQ ID NO: 19. Claims 71-84 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to non-elected invention.
2. Currently claims 37-84 are pending.
3. Claims 37-70 are under nsideration.

***Drawings***

4. The drawings are objected to by the Draftsperson under 37 CFR 1.84 or 1.152. See attached form PTO 948.

***Abstract***

5. This application does not contain an abstract of the disclosure as required by 37 FR 1.72(b). An abstract on a separate sheet is required.

***Information Disclosure Statement***

6. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A (1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

***Priority***

7. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

Complete priority statement is missing from specification:

A statement reading " This application claims priority to Cuban application No. CU1999/71, filed on 6/10/1999" should be entered following the title of the invention or as the first sentence of the specification. Also, the current status of the parent provisional application(s) should be included. A claim for priority under 35 U.S.C. 119 (a) (d) (f) cannot be based on said application, until proper corrections are made.

***Specification***

8. The disclosure is objected to because of the following informalities:

Specification page 12, example 3 is misspelled. The word mixtures in the last line of page 12 and first line of page 13 is repeated.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 37-70 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one

Art Unit: 1645

skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a written description rejection.**

Claims 37-70 recite a LPS binding and neutralizing peptide comprising an amino acid sequence X-1-2-3-4-5-6-7-8-9-10-11-12-13-14-Y which encompass numerous variants and subspecies. Some claims are further limited to specific lengths or larger polypeptides. The claims alternatively recite polypeptides substituted by non-natural homologous amino acid sequences.

The specification and the claims do not indicate what distinguishing attributes are shared by the members of the genus. Thus the scope of the claims include numerous structural variants, and the genus is highly variant because a significant number of structural differences between genus members is permitted. Since the disclosure fails to describe the common attributes or characteristics that identify the members of the genus, and because the genus is highly variant. One skilled in the art would reasonably conclude that the disclosure fails to provide a representative number of species to describe the genus of the variants. Thus applicant was not in possession of the claimed genus.

Adequate written description requires more than a mere statement that is part of the invention and a reference to a potential method of isolating it. The protein itself is required. See *Fiers v. Revel*, 25 USPQ 2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. v. Chugai Pharmaceutical Co. LTS.* 18 USPQ 2d 1016. Applicant is directed to the Revised Interim Guidelines for the Examination of Patent Application Under 35 U.S.C. 112, 1 "Written Description" Requirement, Federal Register, Vol. 64, No.244, pages 71427-71440, Tuesday December 21, 1999.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

12. Claims 37-70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite a LPS binding and neutralizing peptide. It is unclear if the limitation LPS binding and neutralizing peptide is to be applied to the substituted versions as well as the derivative recited in claim 37 and all the species encompassed by claim 37 and further by claims 38-70.

### ***Conclusion***

13. No claims are allowed.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khatol Shahnan-Shah whose telephone number is (703) 308-8896. The examiner can normally be reached on 7:30 AM - 4 PM from Monday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F Smith, can be reached on (703) 308-3909. The fax phone number for the organization where this application or proceeding is assigned to is (703) 305-3014.

Art Unit: 1645

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

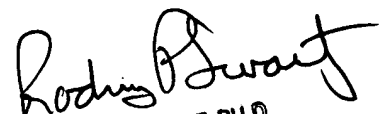


Khatol Shahnan-Shah, BS, Pharm, MS

Biotechnology Patent Examiner

Art Unit 1645

June 27, 2003



RODNEY P. SWARTZ, PH.D.  
PRIMARY EXAMINER